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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,505	04/23/1999	LYNN HOLM-BLAGG	06042-0110	2096

7590 01/23/2002

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 01/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/298,505</b>	Applicant(s) <b>Holm-Bragg et al</b>
	Examiner <b>Andrew J. Fischer</b>	Art Unit <b>2167</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on Nov 8, 2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 2-6, 8-13, 15-20, and 25-29 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 2-6, 8-13, 15-20, and 25-29 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a)  All b)  Some\* c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

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## DETAILED ACTION

### *Specification*

1. The specification is objected to because of the missing serial numbers in the "Related Applications" section. Appropriate correction is required.

### *Claim Objections*

2. Claims 3, 5, 6, 8-11, 13, and 19, are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims fail to recite any additional steps.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-6, 8-13, and 21-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- a. Claims 3, 5, 6, 8-13, 15-20 are indefinite or incomplete since they fail to recite any additional method steps. See *Ex parte Erlich*, 3 USPQ2d 1011, 1017 (B.P.A.I. 1987).

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b. In claims 4 and 26, the phrases, “a second dependent strategy” and “a dependent strategy” are indefinite since the metes and bounds of the claim can not be ascertained. It is unclear what elements would make up “a second dependent strategy . . .”

c. In claim 5, there are no additional steps. It is therefore unclear whether Applicants are claiming a method or an apparatus.

d. In claim 6, there are no additional steps. It is therefore unclear whether Applicants are claiming a method or an apparatus.

e. It is unclear if the “first set of parameters” defines “a set of group processing options” as recited in claim 10, or if the “first set of parameters ... specif[ies] the fist dependent account’s relationship to the group as recited in 27—claim 10’s immediate parent claim. It appears these are mutually exclusive definitions.

f. In claim 27, it is unclear what is a “first dependent account” since claim 26 states it corresponds to the second dependent account while claim 27 states its linked by the “first” dependent financial record . . .” The meaning of a term in a claim must be defined in an manner that is consistent with its appearance in other claims in the same patent. *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987).

g. In claim 25, the limitation “providing said first financial transaction product from the group” is unclear since the first financial transaction product is from the first financial transaction account, and in turn, the first account holder. Claim 26 appears to define the group as something other than defined in claim 25—its immediate parent claim. It is unclear therefor if

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“the group” is the group associated with the master data record or “a group” setting up a Markush claim. Again, the meaning of a term in a claim must be defined in a manner that is consistent with its appearance in other claims in the same patent. *Id.*

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 2, 3, 5, 6, 8-13, 15-20, and 25-29, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Picciallo (U.S. 6,044,360). Picciallo discloses the following: a first account holder or primary owner (the account holder) having both a first financial transaction account (the main account) and a first account financial record (the master record sent to the primary owner); the first financial transaction account having a first financial transaction product (an ATM, visa, or MasterCard either directly issued to the primary owner or in the form of an additional dependent account or “identifier correlated to the secondary file” issued to the owner); a second account holder (the dependent or third party) having both a second financial transaction account (the account identified as the “identifier correlated to the secondary

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file") and a second account financial record (the dependent record sent to the primary owner); group master data record (e.g. the maximum allowable funds for the entire group) linked account financial records; the terms and conditions of the first financial product are different from the terms and conditions of the second financial product (different terms and conditions are different: spending limit, a particular payee or merchant, types of purchases, and transaction limits by the limiting by day, week, or month); a key financial record corresponding to a key account that is associated with the primary owner and is distinct from the group master data (the key financial record is the last entry determining funds available; the amount of funds available is key to the dependent having access to funds; the key account is the number of accounts the account holder has and links the key account to a particular financial account); providing a set of group processing options (the option is the report sent via postal mail or sent via email); the financial products of the first and second products are lines of credit; the dependent accounts may be three or more relating to three different products (line of credit, casino card, a general use, or ATM card); the first dependent account's relationship to the group is independent of the second dependent account's relationship to the group (the first dependent account's relationship to the group is in no way dependent upon the second dependent account's relationship to the group and vice versa; if one relationship were to terminate, the other would not be affected); the group master data includes a group identifier (the computer must somehow identify the group, group control settings, overall spending limit); and group aggregate data (the total number of dependent accounts); and the first dependent account may be deleted from the system (inherent).

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7. During examination, claims are given their broadest reasonable interpretation consistent with the specification. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc). In other words, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>1</sup>

“As always, claim construction begins with the words of the claim. After looking to the claim language we consider the rest of the intrinsic evidence, that is, the written description and the prosecution history . . . .” *Advanced Cardiovascular Systems, Inc. v. Medtronic, Inc.*, 265 F.3d 1294, 60 USPQ2d 1161, 1168 (Fed. Cir. 2001) (citations omitted).

“Generally, there is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art. This presumption is overcome: (1) where the patentee has chosen to be his own lexicographer . . . . In the first situation, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning.” *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 264 F.3d 1326, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (citations omitted).

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<sup>1</sup> Applicant(s) are reminded that while the “claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims, *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) (citations omitted).

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After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning.

However, if Applicant(s) do desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant(s) to expressly indicate the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Failure by Applicant(s) to address this issue in the manner set forth above or other appropriate manner, or to be non-response to this issue entirely will be considered a desire by Applicant(s) to, at least initially, maintain the Examiner's presumption that all claim limitations are given their ordinary and accustom meaning. Applicant(s) are reminded that even though we start with this presumption, any interpretation disclaimed during prosecution may further limit that limitation. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001) (citations omitted).

8. Claims 25-29, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Schein et. al. (WO 97/43893). Schein et. al. discloses the claimed methods including an overall group (the household); Independent account holders (e.g. husband and wife); and multiple accounts for each account holder.

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Picciallo. Picciallo discloses as discussed above and does not directly disclose sending a report to the dependent or third party. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Picciallo to include a report to the dependent or third party. Such a modification would help further Picciallo's goals of teaching the dependent how to budget their money and manage cash flow by showing them where they spent their money.

***Response to Arguments***

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

12. The Examiner notes Applicants have not responded to the objection to the specification in Paper No 7, paragraph No. 1.

13. Regarding the objections to the claims, Applicants have failed to recite any additional steps. While the claims need not recite all of the operating details, a method claim should at least

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recite a positive, active step. *Ex parte Erlich*, at 1017. While the Examiner starts with the presumption that Applicants intend to claim a process, Applicants are reminded that “it is generally the rule that patentability of a method claim must rest on the method steps recited, not on the structure used, unless that structure affects the method steps.” *Leesona Corp. v. US*, 530 F.2d 896, 908 (US Ct Clms 1976). In the case, it is the Examiner’s position that structures does not affect the method steps since, for example, “providing” can be performed with virtually any structure.

14. The Examiner notes Applicants have claimed a process—not a product or a machine, and not combinations of products or machines.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Schein et. al. (U.S. 6,226,623 B1); Gottesman et. al. (U.S. 6,049,782); Walker (U.S. 5,999,596); and Musmanno et. al. (U.S. 5,826,243).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.



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January 20, 2002